

Practitioner's Docket No. IB-1330-1

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent application

of _____
Inventor(s)

for _____
Title of invention

OR

In re application of: Shimon Weiss et al.

Serial No.: 0 9 / 349,833

Group Art Unit: 1641

Filed: July 8, 1999

Examiner: Christopher Chin

For: ORGANO LUMINESCENT SEMICONDUCTOR NANOCRYSTAL PROBES FOR BIOLOGICAL
APPLICATIONS AND PROCESS FOR MAKING AND USING SUCH PROBES

Assistant Commissioner for Patents

Washington, D.C. 20231

TRANSMITTAL OF INFORMATION DISCLOSURE STATEMENT
WITHIN THREE MONTHS OF FILING OR
BEFORE MAILING OF FIRST OFFICE ACTION (37 C.F.R. 1.97(b))

NOTE: "An information disclosure statement shall be considered by the Office if filed by the applicant: (1) within three months of the filing date of a national application; (2) within three months of the date of entry of the national stage as set forth in § 1.491 in an international application; or (3) before the mailing date of a first Office action on the merits, whichever event occurs last." 37 C.F.R. 1.97(b).

To the best of our knowledge, no Office Action has, as yet, been mailed in this case by the USPTO. Therefore, under 37 C.F.R. 1.97(b), no certification under 37 C.F.R. 1.97(e) and 37 C.F.R. 1.97(c) should be necessary nor should a fee be due. However, should any fees be due, authorization is hereby given to charge any such fees to Deposit Order Account 20-0092. A duplicate of this paper is enclosed.

CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. 1.8a)

I hereby certify that this correspondence is, on the date shown below, being:

MAILING

☒ deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Date: September 18, 2000

FACSIMILE

☐ transmitted by facsimile to the Patent and Trademark Office.

John P. Taylor
Signature

John P. Taylor
(type or print name of person certifying)

(Transmittal of Information Disclosure Statement Within Three Months of Filing or Before Mailing of First Office Action [6-3]—page 1 of 2)



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NOTE: The "filing date of a national application" under 37 C.F.R. 1.97(b) has two possible meanings. Where the filing is a direct one to the United States Patent & Trademark Office, the filing is defined in 37 C.F.R. 1.53(b) as "the date on which: (1) A specification containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75; and (2) any drawing required by § 1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by § 1.41." 37 C.F.R. 1.97(b)(1). On the other hand, an international application that enters the national stage occurs when the applicant has filed the documents and fees required by 35 U.S.C. § 371(c) within the periods set forth in § 1.494 or § 1.495. 35 U.S.C. § 371(c) requires the filing of the following: (1) the national fee; (2) a copy of the international application, unless already sent by the International Bureau, and an English translation if filed in another language; (3) amendments under PCT Article 19, with a translation into English if made in another language; (4) an oath or declaration; and (5) a translation into English of any annexes to the international preliminary examination report, if such annexes were made in another language. 37 C.F.R. 1.97(b)(2).

IDENTIFICATION OF TIME OF FILING THE ACCOMPANYING INFORMATION DISCLOSURE STATEMENT

The information disclosure statement submitted herewith is being filed within three months of the filing date of the application or date of entry into the national stage of an international application or before the mailing date of a first Office action on the merits, whichever event occurs last. 37 C.F.R. 1.97(b).

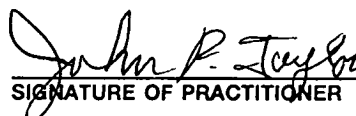
NOTE: "No certification or fee is due when the filing is made within the above time period. It is advisable to ensure that no Office action has been mailed if the disclosure statement is delayed until after three months from filing."

NOTE: "An information disclosure statement will be considered to have been filed on the day it was received in the Office, or on an earlier date of a mailing if accompanied by a properly executed certificate of mailing under 37 C.F.R. 1.8, or Express Mail certificate under 37 C.F.R. 1.10. An Office action is mailed on the date indicated in the Office action." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

NOTE: "The term 'national application' includes continuing applications (continuations, divisions, continuations-in-part) so three-months will be measured from the actual filing date of an application as opposed [sic] to the effective date of a continuing application." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

NOTE: "An action on the merits means an action which treats the patentability of the claims in an application, as opposed to only formal or procedural requirements. An action on the merits would, for example, contain a rejection or indication of allowability of a claim or claims rather than just a restriction requirements (37 C.F.R. 1.142) or just a requirement for additional fees to have a claim considered (37 C.F.R. 1.16(d)). Thus, if an application was filed on Jan. 1 and the first Office action on the merits was not mailed until six months later on July 1, the examiner would be required to consider any proper information disclosure statement filed prior to July 1." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

WARNING: "A petition for suspension of action to allow applicant time to submit an information disclosure statement will be denied as failing to present good and sufficient reasons, since 37 C.F.R. 1.97 provides adequate recourse for the timely submission of prior art for consideration by the examiner." Notice of July 6, 1992 (1141 O.G. 63).


SIGNATURE OF PRACTITIONER

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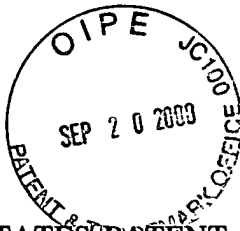
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DOCKET NO. IB-1330-1



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Shimon Weiss et. al.)

Filed: July 8, 1999)

Serial Number: 09/349,833)

Title: "Organo Luminescent Semiconductor
Nanocrystal Probes for Biological
Applications and Process for Making
and Using Such Probes")

Group Art Unit: 1641

Examiner: Christopher Chin

I hereby certify that this correspondence is being
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on September 18, 2000

(Date of Deposit)

John P. Taylor, Reg. No. 22,369

John P. Taylor
Signature

INFORMATION DISCLOSURE STATEMENT UNDER 37 CFR 1.56 September 18, 2000

Date of Signature

Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231

September 18, 2000

Sir:

Pursuant to 37 CFR 1.56, Applicants hereby submit the references listed on Form PTO-1449 (modified) of this Information Disclosure Statement (IDS). The references now being cited in this case in this IDS were cited to the USPTO in three (3) Information Disclosure Statements filed in related application Serial No. 09/259,982. Five of the references in this IDS were cited in a PCT International Search Report (ISR) mailed on August 14, 2000 (copy attached), in the corresponding foreign application of related application Serial No. 09/259,982. The other two references cited in the ISR are not cited in this IDS because (a) Weiss et al. U.S. Patent 5,990,479 is the now issued parent of the instant application; and (b) Dabbousi was already cited herein in the IDS submitted with the filing of this application. Copies of each of the references listed on Form PTO-1449 of this IDS are enclosed.

Respectfully submitted,

By: John P. Taylor

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